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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,298	09/25/2000	Saleem Ahmad	HA0744 NP	2733

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EXAMINER
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LIU, HONG

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 03/07/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/669,298

Applicant(s)

AHMAD ET AL.

Examiner

Hong Liu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 29 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-3,6,8-10,14,15,17,19,20,22,24-31 and 63-74 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 28-30 and 63 is/are allowed.
- 6) ☐ Claim(s) 1-3,6,8-10,14,15,17,19,20,22,24-27,31 and 64-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Claims 1-3, 6, 8-10, 14, 15, 17, 19, 20, 22, 24-31, and 63-74 are pending in this application.

This action is in response to the applicants' amendment and reply filed on January 29, 2002.

### **Response to Arguments**

Applicants' arguments filed on January 29, 2002 have been fully considered but they are not persuasive. Rejections to Claims under 35 U.S.C., second paragraph, 102(b), and 103 are maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 102***

The rejection to claims 1-4, 6-10, 12-19, 22, 24, 25 and 31 under 35 U.S.C. 102(b) as being anticipated by Even et al is hereby withdrawn. Applicants deleted "heteroarylcarbonyl" for R1 to overcome the rejection.

Claims 1-4, 6-10, 12, 13, 15-19, 22, 24, 25 and 31 remain rejected and claims 64-70 and 72-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Ganellin et al. Pyridine anticipates heteroaryl.

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The rejection to claims 1, 2, 4, 6, 8-10, 12, 15, 16, 17, 22, 24, and 31 under 35 U.S.C. 102(b) as being anticipated by Corbel et al. is hereby withdrawn. Applicants deleted "alkylcarbonyl" from R1 definition to overcome the rejection.

The rejection to claims 1, 2, 4, 6, 10, 12, 14-16, 22, 24, 25, and 31 under 35 U.S.C. 102(b) as being anticipated by Schunack et al. is hereby withdrawn. Applicants deleted "H" from R1 to overcome the rejection.

Claims 1, 2, 4, 6-10, 12, 14-16, 22, 24, 25 and 31 remain rejected and claims 64-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Arrang et al. The reference species still read on such functional groups as aminocarbonyl.

Claims 1-4, 6-10, 12, 13, 15-18, 22, 24, 25 and 31 remain rejected and claims 64-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Jagham et al. (US Patent 5,280,030). The bicyclic ring anticipates heteroaryl.

The rejection to claims 1, 2, 4, 6, 8-10, 12, 15, 16, 22, 25, and 31 under 35 U.S.C. 102(b) as being anticipated by Jagham et al. (US Patent 5,434,169) is hereby withdrawn. Applicants amended R1 to exclude arylcarbonyl or heterocarbonyl, overcoming the rejection.

Claims 1, 2, 4, 6, 8-10, 12, 14, 16, 22, 24, 25, and 31 remain rejected and claims 64-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Durant et al. (US Patent 5,663,350). R2 can be piperonyl.

Claims 1, 2, 4, 6, 10, 12, 14-16, 22, 24, 25, and 31 remain rejected under 35 U.S.C. 102(b) as being anticipated by Lange et al. The reference compound contains a carboxy group attached to the nitrogen of the piperidine ring.

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Claims 1-3, 6, 8-10, 14, 15, 17, 19, 20, 22, 24-27, 31, 64-74 are rejected under 35 U.S.C. 102(b) as being anticipated by Jegham et al. (WO 99/31089). Jegham teaches the compounds and composition of the instant invention (see Examples).

***Claim Rejections - 35 USC § 103***

The rejection to claims 1, 2, 4, 6-10, 12, 14-16, 22, 24, 25 and 31 under 35 U.S.C. 103(a) as being unpatentable over Arrang et al. (US Patent 4,707,487) is maintained for the same reason given in the 102 rejection.

The rejection to claims 1-4, 6-10, 12-19, 22, 24, 25 and 31 under 35 U.S.C. 103(a) as being unpatentable over Jagham et al. (US Patent 5,280,030) is maintained for the same reason given in the 102 rejection.

The rejection to claims 1, 2, 4, 6, 8-10, 12, 14-16, 22, 25 and 31 under 35 U.S.C. 103(a) as being unpatentable over Jagham et al. (US Patent 5,434,169) ) is hereby withdrawn for the same reason given in the 102 rejection..

The rejection to claims 1, 2, 4, 6, 8-10, 12, 14, 16, 22, 24, 25, and 31 under 35 U.S.C. 103(a) as being unpatentable over Durant et al. (US Patent 5,663,350) is maintained for the same reason given in the 102 rejection.

Claims 1-3, 6, 8-10, 14, 15, 17, 19, 20, 22, 24-27, 31, 64-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jegham et al. (WO 99/31089). The reference teaches a generic group of compounds which embraces applicant's instantly claimed compounds. See formula I, page 1 wherein n can be 2 and m can be 0, etc. The compounds are taught to be useful as H3 receptor inhibitors. The claims differ from the reference by reciting a specific species

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and/or a more limited genus than the reference. However, it would have nevertheless been obvious to one skilled in the art at the time of the invention to be motivated to select any of the species of the genus taught by the reference including those instantly claimed, because the skilled chemist would have the reasonable expectation that any of the specie of the genus would have similar properties and, thus, the same use as taught for the genus as a whole agents. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole. It has been held that a prior art disclosed genus of useful compounds is sufficient to render prima facie obvious a species falling within a genus. See *In re Susi*, 440 F.2d 442, 169 USPQ 423, 425 (CCPA 1971), followed by the Federal Circuit in *Merck & Co. V. Biocraft Laboratories*, 847 F.2d 804, 10 USPQ 2d 1843, 1846 (Fed. Cir. 1989).

***Claim Rejections - 35 USC § 112***

The rejection to claims 1-4, 6-10, 13-20, 22, 24-27, and 31 under 35 U.S.C. 112, first paragraph is hereby withdrawn. Applicants' arguments have been found persuasive.

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Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Provisos have been included in the claim (see amended claim 1). The proviso lacks description. Even negative limitations require a description. The MPEP at 2173.05(I) Negative Limitation states "Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231USPQ 393 (Bd. App. 1983) *aff'd mem.*, 738 F. 2d 453 (Fed. Cir. 1984)" and further, "Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement." In the instant case, the new concept that has been introduced by the proviso is the specific relationships between Z and R1. This specific relationship of connectivity was previously not disclosed. This notion that the definition of one variable depends on the definitions of other variables is new. The definition of a variable is no longer independent.

The rejection to claims under 35 U.S.C. 112, second paragraph is hereby withdrawn. Applicants have amended the claims to overcome the rejection.

1. Claim 14 and all its dependent claims recite the limitation of the zigzag symbol. There is insufficient antecedent basis for this limitation in the claim. In addition, it is unclear what constitutes the linker defined by the zigzag symbol.

*Allowable Subject Matter*

Claims 28-30 and 63 are allowable. None of the prior art of record nor a search in the pertinent art area teaches the exact species of these claims.

2.

*Conclusion*

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


4. Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (703) 306-5814. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM. If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached at (703) 308-4716. The fax phone number for this group is (703) 308-4734 for "unofficial" purposes and the actual number for official business is (703) 308-4556. Any inquiry of a general nature or relating to the



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status of this application or proceeding should be directed to the Group receptionist whose number is (703) 308-1235.

hl  
March 6, 2002

  
Mukund Shah  
Supervisory Patent Examiner  
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